



ATTORNEY Docket: 40526.09101
PATENT

#10
1-803

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Stephen B. Maguire
Serial Number : 10/084,030
Group Art Unit : 3651
Filed : February 27, 2002
Examiner : Joseph A. Dillon, Jr.
Title : VACUUM LOADING SYSTEM

RECEIVED

JAN 07 2003

GROUP 3600

RESPONSE TO RESTRICTION REQUIREMENT

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

Traverse, Request For Reconsideration And Provisional Election

This is submitted in response to an office action having no paper designation number but dated October 30, 2002 wherein the examiner required restriction of the subject matter disclosed in the above-referenced patent application.

Applicant, through his undersigned attorney, hereby traverses the restriction requirement in all of its respects, requests reconsideration and withdrawal of the requirement for restriction and further requests a prompt and thorough examination of all of the claims pending in the application, on their merits.

Without prejudice to the foregoing traverse and request for reconsideration and without prejudice to Applicant's right to petition against the restriction requirement, in compliance with the requirement set forth in the official action Applicant provisionally elects the claims of Group I, namely claims 1-2, 20-22, 25 and 27, which the Examiner has characterized as being directed to a receptacle for granular material, for immediate examination.

Legal, Practical and Equitable Considerations Mandate Examination of Applicant's Claims in a Single Action

A close examination of the legal, practical and equitable considerations surrounding this application compels withdrawal of the examiner's restriction requirement and requires examination of all the claims pending in the application.

In levying the restriction requirement, the examiner divided the claims pending in the application into four groups. The examiner asserted that Group I embraced claims 1-2, 20-22, 25 and 27 which are purportedly drawn to "a receptacle for granular material" and which the examiner asserted to be classified in class 406, subclass 127.

The examiner asserted Group II to embrace claims 3-9, 23-24 and 26, which are purportedly drawn to a "receptacle for feeding resin to a plurality of hoppers" and which the examiner asserted to be classified in class 406, subclass 123.

The examiner asserted Group III to embrace claims 10-19 which are purportedly drawn to a "method of conveying", which the examiner asserted to be classified in class 406, subclass 197.

The examiner further asserted that Group IV constituted claim 28 by itself which was purportedly drawn to a "blender with pneumatic conveying" and which the examiner asserted to be classified in class 406, subclass 198.

The examiner then asserted that the claims in these four groups defined inventions which were purportedly "distinct" and that such distinctness mandated restriction.

Applicant respectfully notes that in the restriction context the test for whether inventions, defined by groups of claims, are "distinct" is a multi-prong test: "Distinct means that two or more subjects as disclosed are related...but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER". *MPEP 802.01*. (emphasis in the original)

The examiner asserted that the inventions of groups 1 through 4 were all related, either as subcombinations allegedly being disclosed as being usable together in a single combination, or as a process and apparatus for its practice. (Hence the examiner has conceded on the record that the inventions of the four groups are "related.") The examiner then contended that the subcombinations "are distinct from each other if they are shown to be separately usable" and that the process and apparatus groupings were distinct because either "(1) the process as claimed can be practiced by another materially different apparatus or by hand or (2) the apparatus as claimed can be used to practice another and materially different process".

Notably, the examiner made no reference whatsoever to the patentability prong of the distinctness test, namely whether the inventions (defined by each one of the separate, allegedly distinct, groups of claims) are novel and unobviously patentable respecting the inventions defined by the other three groups of claims.

In each of the three instances where the examiner contended that the inventions of two groups were related as "process and apparatus for its practice" (Group 1 vis-à-vis Group 3, Group 2 vis-à-vis Group 3 and Group 3 vis-à-vis Group 4), the examiner contended that "the process as claimed can be practiced by another materially different apparatus **or by hand**" (emphasis added) and cited MPEP 806.05(e) as supporting authority.

In each of the three instances where the examiner contended that the inventions of two groups were "related as subcombinations disclosed as usable together in a single combination", namely Group 1 vis-à-vis Group 4, Group 2 vis-à-vis Group 4 and Group 1 vis-à-vis Group 2, the examiner asserted that one of the alleged "subcombinations" had "separate utility" as respects the remaining one of the alleged "subcombinations". In the cases of Group 1 vis-à-vis Group 4 and Group 2 vis-à-vis Group 4, the examiner asserted that such separate utility involved use of the invention defined by the claims of Group 4 as a "blender". In the case of Group 1 vis-à-vis Group 2, the examiner asserted that such separate utility involved use of the invention defined by the claims of Group 1 as a "conveyor for granular material". In all three of these "subcombination" instances the examiner cited MPEP 806.05(d) as supporting authority.

Concerning the restriction requirement involving the method/apparatus distinction, namely the requirement for restriction of Group 1 vis-à-vis Group 3, Group 2 vis-à-vis Group 3 and Group 3 vis-à-vis Group 4, Applicant respectfully submits that the restriction requirement is unsupportable and should be withdrawn.

The examiner asserted in all three instances in support of the method/apparatus restriction requirement that "the process as claimed can be practiced by hand". This is incorrect. Claim 10, the independent method claim in Group 3, recites as the first step of the claimed method "drawing a vacuum within a receptacle thereby inducing plastic resin material flow".

Applicant respectfully notes that it is impossible to draw a vacuum "by hand" and that it is also clearly impossible to draw manually, i.e. with one's hand, a vacuum within a receptacle which would be sufficient to induce plastic resin material flow into that receptacle. This being the case, the examiner's contention and stated basis for the alleged distinction between and among the claims of Group 1 vis-à-vis Group 3, Group 2 vis-à-vis Group 3 and Group 3 vis-à-vis Group 4 is unsupportable. Accordingly, the restriction requirement between and among the claims of Group 1 vis-à-vis Group 3, Group 2 vis-à-vis Group 3 and Group 3 vis-à-vis Group 4 should be withdrawn.

As to the "subcombination" restriction involving the claims of Group 1 vis-à-vis Group 4, Group 2 vis-à-vis Group 4 and Group 1 vis-à-vis Group 2, Applicant initially notes that the examiner has mischaracterized the single claim of Group 4 as being allegedly directed to a "subcombination". The single claim

of Group 4 is directed to a combination, namely a molding press, a gravimetric blender furnishing material to the press and pneumatic feed means for supplying material to the blender. There is **no** subcombination, within the context of the instant application or the claim groupings, defined by the claim of Group 4. Rather, the invention defined by the claim of Group 4 could use the inventions defined by the claims of Groups 1 and 2 as the pneumatic feeding means.

The inventions defined by the claims of Groups 1 and 2 are arguably usable as subcombinations of the invention defined by the single claim of Group 4, but the invention defined by the sole claim of Group 4 is **not** a subcombination as respects the inventions defined by the claims of Groups 1 and 2. Given this error by the examiner, Applicant submits it to be clear that the "subcombination" restriction requirement involving the claims of Group 1 vis-à-vis Group 4, Group 2 vis-à-vis Group 4 and Group 1 vis-à-vis Group 2 is erroneous and should be withdrawn.

In support of the erroneously levied restriction requirement, the examiner cited MPEP 806.05(d) which states that two or more claimed subcombinations which are disclosed as being usable together in a single combination "are usually distinct from each other" if they can be shown to be separately usable. It should be specifically noted that MPEP 806.05(d), on which the examiner based his distinctness position, addresses only the "separately usable" prong of the multi-prong test for distinctness; MPEP 806.05(d) is **silent respecting the patentability prong of the distinctness test**, namely **whether the inventions defined by the claims at issue are patentable over each other**.

Applicant is not necessarily in agreement with the examiner that the inventions defined by the claims, as segregated into the four groups which the examiner has defined, represent groups of inventions which are usable in any meaningful way alone, without using any of the inventions defined by the claims of another one of the four groups.

Applicant respectfully submits that, **for purposes of restriction analysis only** and without prejudice to whatever position applicant may take on patentability in the course of prosecution of the claims on their merits, the claims in the four groups into which they have been segregated by the examiner may not be patentable over one another. Without prejudice to that position, applicant respectfully notes that whether or not the claims of the respective four groups are patentable over one another, it is the examiner's burden to show lack of patentability of the groups of claims vis-à-vis one another in order to satisfy the patentability prong of the distinctness test.

Applicant respectfully notes that the restriction requirement is silent respecting the patentability of any claim, in any one of the four groups of claims, vis-à-vis any claim in any of the other three groups. Applicant further respectfully notes that the fact that the claims have been arbitrarily categorized into separate classes and subclasses by the examiner in levying the restriction requirement does not address the issue of the patentability of the groups of claims vis-à-vis one another in the context of the patentability prong of the distinctness test for purposes for restriction analysis. Indeed, Applicant notes that there are many

common elements shared by the independent claims the examiner segregated into separate, purportedly "distinct", groups.

For the foregoing reasons, applicant respectfully submits that the examiner's restriction requirement is erroneous, does not meet the controlling criteria for a finding of distinctness and should be withdrawn.

The examiner has further based the distinctness position on an assertion that the inventions defined by the four segregated groups of claims are distinct because they purportedly "have acquired a separate status in the art as shown by their different classification...". Applicant respectfully submits that this bald conclusion does not support a finding of distinctness. Classification in the sense used by the examiner relates to where the patents, which might issue containing such claims, would be classified. Asserting that the issuing patents would be differently classified presumes that the claims of the prospective patents would be patentably distinct one from another. However, as demonstrated above, there has been no showing by the examiner of patentable unobviousness among the four groups of claims. Without a showing of patentable unobviousness among the four groups of claims, the assertion that the claims in the four groups, were they to issue in different patents, would be in four different classes is unsupported speculation.

The examiner has also asserted that the claims defining the four groups of the invention are distinct because they purportedly "have acquired a separate status in the art because of their recognized divergent subject matter...". Applicant respectfully submits there has been no showing of any divergent

subject matter. Indeed, a straight-forward reading of the claims reveals that there are elements which are common to the claims of the four groups, as discussed generally above. There has not been a showing of the claims defining the inventions of the four groups having acquired any separate status in the art or having been recognized by anyone as presenting "divergent" subject matter. Indeed, all of the claims in all of the groups are broadly directed towards aspects of feeding and processing granular plastic resin materials. Applicant respectfully submits that far from presenting "divergent" subject matter, the claims arguably could better be characterized as presenting "convergent" subject matter. All of the claims could certainly be considered to converge towards granular material processing leading up to molding or extrusion of the granular resin material into useable products.

The Required Scope Of The Search

The most salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicant is entitled to a full and thorough search of the prior art as a consequence of having filed his application and having paid the statutory application fee:

The director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the director shall issue a patent therefor. 35 U.S.C. 131

Restriction is proper only where an examiner would be unduly burdened by searching numerous, **unrelated** inventions or technologies. The scope of a

search for related inventions, even though possibly burdensome, cannot by itself justify restriction of related inventions. If an application includes claims to related inventions that are distinct or independent inventions, the examiner **must** examine the application on its merits, in its entirety, if the search and examination of the entire patent application can be made without a serious burden on the examiner:

If the search and examination of **an entire application** can be made without serious burden, the examiner **must examine it on the merits, even though it includes claims to independent or distinct inventions**. MPEP 803.

In developing a search strategy and mapping the scope of a search, claims are to be given their broadest reasonable interpretation, both literally and by equivalents:

All subject matter that is the equivalent of the subject matter as defined in the claim, even though specifically different from the definition in the claim, must be considered unless expressly excluded by the claimed subject matter. MPEP 904.01(b)

The examiner will not be unduly burdened by searching and examining all of the claims presented by applicant in a single application. The examiner's search will not be narrowed or reduced by compliance with the restriction requirement, since applicant has clearly manifested his intent to claim each novel and nonobvious aspect of the disclosed subject matter as evidenced by the claims in the application.

The examiner's instructional guidelines for performing a search for any application are set forth in the MPEP. The guidelines require the examiner to

search in classes and subclasses in which arguably distinct (as defined by the MPEP) inventions would be classified:

"Not only must the art be searched with which the invention claimed is classifiable, but **also all analogous arts regardless of where classified.**

The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. MPEP 904.01(c) (emphasis added).

A proper field of search normally includes the subclass in which the claimed subject matter of an application would be properly classified...

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, **that may have material pertinent to the subject matter as claimed.** Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. **The search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.** MPEP 904.02(a) (emphasis added).

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, **commensurate with the limitations appearing in the most detailed claims** in the case, be made in preparing the first action ... It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; **but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.** MPEP 904.03, ¶ 1 (emphasis added)

In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention, by showing that this other subject matter is old or obvious. MPEP 904.03 ¶ 2

In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's disclosure... MPEP 904.03 ¶ 3.

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

- (1) Classes and subclasses in which the claimed subject matter is classified;
- (2) Classes and subclasses that may have material pertinent to the claimed subject matter;
- (3) Classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; and
- (4) Classes and subclasses that may contain subject matter disclosing material related to features which might reasonably be expected to be claimed.

Given this mandate, Applicant submits that all of the classes defined by the examiner as those in which the claims of this application arguably reside, must be searched no matter which group of claims Applicant elects for immediate prosecution.

The Proposed Restriction Would Be Unduly Economically Burdensome On Applicant

While the Patent and Trademark Office has a legitimate interest in obtaining proper revenue from filing, issuance and maintenance fees, it does not have unrestrained power to tax inventors or the entrepreneurial enterprises employing them. Applicant is entitled to obtain patent protection on each of the nonobvious inventive aspects of the subject matter which applicant has disclosed. If the applicant is forced to divide this application into four separate

patent applications as suggested by the examiner, this will be unduly and unfairly burdensome to the applicant due to the extra fees and costs associated with prosecuting and maintaining three additional patents.

Table 1 sets forth the divisional application filing costs which would be incurred by the applicant in the event the restriction requirement stands:

TABLE 1: DIVISIONAL APPLICATION FILING COST

Group Number	I	II	III	IV
Independent Claims	1	1	2	1
Excess Independent Claims	0	0	0	0
Excess Independent Claim Fee	0	0	0	0
Total Claims	7	10	10	1
Excess Claims	0	0	0	0
Excess Claims Fee	0	0	0	0
Basic Filing Fee	375.00	375.00	375.00	375.00
Total Filing Fee	<u>375.00</u>	<u>375.00</u>	<u>375.00</u>	<u>375.00</u>
Excess Filing Fees				
Already Paid by Applicant at Filing		\$513.00		
Already Paid by Applicant to Add Claims 25-28		\$ <u>69.00</u>		
Filing & Claims Fees Paid by Applicant to Date		\$582.00		

As can be seen from Table 1, after 1 January 2003, Applicant will be forced to pay additional filing fees in the amount of \$1125.00 (3 x \$375.00) to file divisional applications in the event the restriction requirement is not withdrawn.

As further indicated on Table 1, Applicant has already paid \$582.00 in filing and claims fees to date. If Applicant is forced to adhere the restriction

requirement, this will be forfeited since four independent claims and 21 claims in total will not be examined in the instant application despite the fact that applicant has paid the fees therefor. Indeed, applicant will be forced to pay \$1125.00 additional to secure examination of the three extra independent claims and the 21 total extra claims for which applicant has already paid. Hence, applicant will incur an initial, non-recoverable penalty of \$1707.00 (\$1125.00 + \$582.00) in the event applicant is required to adhere to the outstanding restriction requirement and file divisional applications for the three non-elected groups of claims.

Table 2 presents the patent issue fees and maintenance costs applicant will face in the event the restriction requirement stands and applicant is successful in prosecuting the parent application and three divisional applications to allowance:

TABLE 2: PATENT MAINTENANCE COST

Number of Patents	1	2	3	4
Issue Fee	650.00	1300.00	1950.00	2600.00
1 st Maintenance Fee	445.00	890.00	1335.00	1780.00
2 nd Maintenance Fee	1025.00	2050.00	3075.00	4100.00
3 rd Maintenance Fee	<u>1575.00</u>	<u>3150.00</u>	<u>4725.00</u>	<u>6300.00</u>
TOTAL	\$3,695.00	\$7,390.00	\$11,085.00	\$14,780.00

Even from Table 2, which presents the maintenance fee costs at today's, December 2002, levels, it is apparent that applicant will face issue and

maintenance fees amounting to \$11,085.00 extra, over and above the cost to issue and maintain a single patent directed to the invention, if the restriction requirement stands. When this figure is combined with the figures discussed above, the total financial penalty applicant potentially faces in just official fees amounts to \$12,792.00 as a result of the restriction requirement. Applicant respectfully submits that applicant should not be burdened in this manner and that the restriction requirement should be reconsidered and withdrawn in its entirety.

**The Patent Office's Responsibility Is Public Service,
Not Revenue Generation**

While applicant recognizes the Patent and Trademark Office interest in obtaining proper revenue from filing and issuance fees, the Patent and Trademark Office is not in the business of assisting the IRS in financing the war on terrorism or reducing the national debt. The sole function of the Patent and Trademark Office is to serve inventors and the public in an efficient and expeditious manner. The Patent and Trademark Office is charged with a duty to carry out its responsibility of examining patent applications thoroughly and efficiently. Efficient use of administrative resources and expeditious processing of this application will be better served by performing one comprehensive search, as contrasted to four largely, if not completely, overlapping searches of the classes defined by the examiner in levying the erroneously-based restriction requirement.


Conclusion

For all of the foregoing reasons, applicant respectfully submits that the restriction requirement set forth in the paper dated October 30, 2002 is not well founded and should be withdrawn. Applicant again requests prompt and thorough examination of all of the claims pending in the application.

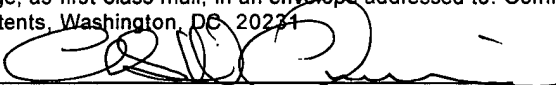
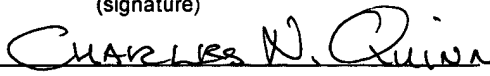
In the event there is any fee required in connection with this submission, please charge the same to applicant's undersigned counsel's Deposit Account No. 50-1943.

Respectfully submitted,

30 December 2002


CHARLES N. QUINN
Registration No. 27,223
Attorney for Applicant

Fox, Rothschild, O'Brien & Frankel, LLP
2000 Market Street, 10th Floor
Philadelphia, PA 19103
Tel: 215-299-2135
Fax: 215-299-2150
email: cquinn@frof.com

CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8(a)	
I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, Washington, DC 20231	
 (signature)	
BY:	
DATE:	<u>30 December 2002</u>